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EXAMINER

BOCHNA, DAVID

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID LLEWELLYN MALLIS and
HARRIS ALLEN REYNOLDS

Appeal 2008-2420
Application 09/977,746
Technology Center 3600

Decided:¹ February 9, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

David Llewellyn Mallis and Harris Allen Reynolds (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 10-19, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention relates to threaded tubular joints usable in oil and gas well drilling and production and, in particular, to a wedge thread having a positive stop torque shoulder for connecting male (pin) and female (box) members. Spec. 1, para. 0001. Claim 10, reproduced below, is representative of the subject matter on appeal.

10. A method comprising:

rotationally engaging a pin member and a box member, the pin member having an external thread increasing in width in one direction, the external thread comprising load and stab flanks, the box member having an internal thread increasing in width in the other direction, the internal thread comprising load and stab flanks, the pin member and box member defining a positive stop torque shoulder,

wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Blose	US 4,822,081	Apr. 18, 1989
Klementich	US 5,462,315	Oct. 31, 1995

The Appellants seek review of the following Examiner's rejections:

1. Claims 10-19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 10, 11, and 15-19 under 35 U.S.C. § 102(b) as anticipated by Klementich.
3. Claims 12-14 under 35 U.S.C. § 103(a) as unpatentable over Klementich and Blose.

ISSUES

The Examiner determined that “the claims purport that no irreversible plastic deformation occurs at final makeup yet the specification only supports no irreversible plastic deformation prior to final make up.” Ans. 3. The Appellants argue that “not having plastic deformation of the positive stop torque shoulder occur ‘upon final makeup,’ as recited in claim 10, is equivalent to not having plastic deformation occur ‘prior to final make up.’” Br. 7. The Appellants further argue that “[i]t likely follows that if no plastic deformation occurs prior to final makeup, no plastic deformation would occur upon final makeup, as plastic deformation occurring exactly at the point of final makeup would not be possible.” *Id.*

The first issue presented by this appeal is:

Have the Appellants shown that the Examiner erred in determining that the Specification fails to provide adequate written descriptive support for “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup”?

The Examiner found that the tubular connection disclosed in Klementich anticipates the subject matter of claims 10, 11, and 15-19 and renders obvious, in combination with Blose, the subject matter of claims 12-14. Ans. 3-5.

The Appellants argue that Klementich does not anticipate the claimed method “[b]ecause Klementich is silent as to the existence or avoidance of plastic deformation in a positive stop torque shoulder upon final makeup” and that the claimed method is not obvious because “Blose does not show or suggest that which Klementich lacks.” Br. 9 & 13.

The second issue presented by this appeal is:

Have the Appellants shown that the Examiner erred in determining that Klementich discloses “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup”?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Appellants' Specification describes, "In a preferred embodiment, the internal and external thread widths are selected so that a selected clearance exists at least between the internal and external load and stab flanks, upon engagement of the positive stop torque shoulder. In this arrangement, torque may be applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation." Spec. 5-6, para. 0026 and Spec. 7, para. 0031.
2. The Specification contains no explicit description of avoiding plastic deformation upon final makeup. Spec., *passim*.
3. The Examiner found that "Klementich is silent as to any type of plastic deformation occurring during the makeup of the connection." Ans. 7.
4. The Examiner further found that "[t]here is not enough evidence or support in the specification of Klementich to allow one of ordinary skill in the art to conclude that plastic deformation occurs during the makeup of the threaded joint." Ans. 8.
5. Blose discloses mating shoulders 41 and 43 and end faces 42 and 44 that become deformed after making contact upon driving forces

where the shoulders may deform unelastically during driving of the casing. Blose, col. 9, ll. 23-33.

PRINCIPLES OF LAW

The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “[T]he written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). In deciding the issue of written description, the specification as a whole must be considered. *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989).

On the one hand, the claimed subject matter need not be described “*in haec verba*” in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989). Rather, “the specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed.” *Id.* at 424 (quoting *In re Smith*, 481 F.2d 910, 914 (CCPA 1973)).

On the other hand, the written description requirement is not necessarily met as a matter of law because the claim language appears *in*

ipsis verbis in the specification. *Enzo Biochem*, 323 F.3d at 968 (“Even if a claim is supported by the specification, the language of the specification, to the extent possible, must describe the claimed invention so that one skilled in the art can recognize what is claimed.”). “The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.” *Id.* (citation omitted).

ANALYSIS

Written Description Rejection

The Appellants argue claims 10-19 as a group. Br. 7-8. We select claim 10 as the representative claim, and claims 11-19 stand or fall with claim 10. 37 C.F.R. § 41.37(c)(1) (vii) (2008).

Claim 10 recites a method “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup.” We have reviewed the Appellants’ Specification in its entirety and have found that the Specification contains no explicit description of avoiding plastic deformation upon final makeup as claimed (Fact 2). The Appellants’ Specification describes only that “torque may be applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation” (Fact 1). Thus, the Specification shows that the Appellants were in possession of a method in which torque may be applied to the positive stop torque shoulder “prior to” final makeup without plastic deformation occurring.

The Appellants fail to sufficiently explain why “plastic deformation occurring exactly at the point of final makeup would not be possible.” Br. 7. It seems entirely possible that one additional incremental measure of torque upon final makeup of the connection could result in plastic deformation. *See* Ans. 5. As such, Appellants’ disclosure of avoiding plastic deformation “prior to” final makeup is not equivalent to, and is not sufficient written descriptive support for, avoiding plastic deformation “upon” final makeup.

Anticipation Rejection

The Appellants argue that Klementich does not anticipate the claimed method “[b]ecause Klementich is silent as to the existence or avoidance of plastic deformation in a positive stop torque shoulder upon final makeup.” Br. 9. The Appellants point to Figures 5A -5C (which show a detailed view of the locked double shoulder configuration of the embodiment of Figure 1), in which Klementich describes that as the shoulders 520 and 540 move into position, they begin to bend slightly. Br. 10. The Appellants argue that despite the prior art’s silence as to whether the bending is plastic or elastic, “one of ordinary skill in the art of rotary threaded oilfield connections would understand that this bending would include both elastic and plastic modes of deformation.” Br. 11.

The Examiner concedes that “Klementich is silent as to any type of plastic deformation occurring during the makeup of the connection” and that “[t]here is not enough evidence or support in the specification of Klementich to allow one of ordinary skill in the art to conclude that plastic deformation

occurs during the makeup of the threaded joint” (Facts 3 & 4). If Klementich lacks adequate disclosure to determine whether plastic deformation occurs, then it also lacks adequate disclosure to determine that plastic deformation is avoided. In other words, Klementich does not disclose by a preponderance of the evidence the claimed feature of “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup.” As such, we cannot sustain the Examiner’s rejection of claim 10, or claims 11 and 15-19 which depend therefrom, as anticipated by Klementich.

Obviousness Rejection

Claims 12-14 depend from claim 10. The Appellants argue that “Blose does not show or suggest the avoidance of plastic deformation of the positive stop torque shoulder upon final makeup of the connection,” and thus Blose does not cure the deficiencies of Klementich. Br. 13. Blose discloses mating shoulders 41 and 43 and end faces 42 and 44 that become deformed after making contact upon driving forces where the shoulders may deform unelastically during driving of the casing (Fact 5). Thus, Blose does not appear to disclose the claimed feature of “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup,” as recited in claim 10. As such, even if combined, the teachings of Klementich and Blose would not render obvious the subject matter of claims 12 and 14, which depend from claim 10.

CONCLUSIONS

The Appellants have failed to show that the Examiner erred in determining the Specification fails to provide adequate written descriptive support for “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup.”

The Appellants have shown that the Examiner erred in rejecting claims 10, 11, and 15-19 as anticipated by Klementich and claims 12-14 as unpatentable over Klementich and Blose, because Klementich, taken alone or in combination with Blose, fails to disclose “wherein a torque is applied such that plastic deformation of the positive stop torque shoulder does not occur upon final makeup.”

DECISION

We affirm the Examiner’s rejection of claims 10-19 under 35 U.S.C. § 112, first paragraph, and we reverse the rejections of claims 10, 11, and 15-19 under 35 U.S.C. § 102(b) and claims 12-14 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Vsh

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